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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,523	06/25/2003	James A. Tennant	JP-001R	4116
7733	7590	11/08/2004	EXAMINER	
WALKER & JOCKE, L.P.A. 231 SOUTH BROADWAY STREET MEDINA, OH 44256			BASINGER, SHERMAN D	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/603,523	<b>Applicant(s)</b> TENNANT, JAMES A. 	
	<b>Examiner</b> Sherman D. Basinger	<b>Art Unit</b> 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,6,9-11,15-17,19-24,28 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8,12-14,18 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 9 is objected to because of the following informalities: the periods at the end of paragraphs e and g should be semi-colons and in line 1 of paragraph g "wherein the wherein the" should be -wherein the-. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 7, 8, 12 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Thibodeau.

The first clamp part is arm 19, the second clamp part is arm 25 and the nose and shoulders are shown in figure 1 with pintle 24 passing through the noses and the shoulders receiving the noses. Arm 19 has one nose and two shoulders while arm 25 has two noses and one shoulder between the two noses.

The stem portion of claim 2 is made up of jaws 21 and 26 each of which extends *adjacent* one side of a portion of a hull of the boat which is in operative connection with the gunwale.

The bracket of claim 7 is made up of arms 16. The item is handle member 12 or blade member 13. The support member is either of gear segments 12a and 13a. The projection of the bracket is either one of the pivot bolts 14.

The tensioning device of claim 12 is made up of bolt 28 and wing nut 30.

With regard to new claim 27, Thibodeau discloses placing a first clamp part 19 adjacent a first side of a gunwale 18 of a boat, placing a second clamp 25 adjacent and in opposing relationship to the first clamp part adjacent a second side of the gunwale 18, fastening the first clamp part and the second clamp part together with either pintle 24 or bolt 28 to form a clamp and including placing a nose part of the first clamp 19 adjacent and in operative relation to a shoulder portion of the second clamp part and placing a nose part of the second clamp part adjacent and in operative relation to a shoulder of the first clamp part whereby the operative relation between the nose part of each clamp part and the shoulder portion of the other clamp part prevents the clamp from opening and releasing the gunwale. The operative relationship of the nose and shoulder parts includes the pintle 24 keeping the nose parts and shoulder parts from separating such that the clamp is prevented from opening at its top where the nose and shoulder are so as to release the gunwale.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 14, 18, 25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibodeau.

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With regard to claim 3, Thibodeau does not disclose that a width of the stem portion is narrower than the width of the gunwale 18. However, bolt 28 and tension nut 30 enable one to make the width of the stem portion more narrow than the width of the gunwale 18. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to adjust wing nut 30 of Thibodeau to make the distance between jaws 21 and 26 more narrow than the thickness of the gunwale in Thibodeau. Motivation to do so is to bring the jaws 21 and 26 into contact or almost into contact with each other for storage of the attachment of Thibodeau.

The fastener of claim 4 is pintle 24.

With regard to claim 14, Thibodeau teaches placing two clamp parts 19 and 25 adjacent sides of a gunwale of a boat wherein each clamp part includes a nose which curves around an uppermost point on the gunwale, fastening the clamp parts together with pintle 24 that extends through each nose part wherein the fastened clamp parts form a clamp with an aperture including an opening portion that extends around the gunwale wherein the aperture further includes a stem portion formed by jaws 21 and 26 that extends *adjacent* each side portion of a hull of the boat which is in operative connection with the gunwale. Thibodeau does not disclose that a width of the stem portion is narrower than the width of the gunwale. However, bolt 28 and tension nut 30 enable one to make the width of the stem portion more narrow than the width of the gunwale. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to adjust wing nut 30 of

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Thibodeau to make the distance between jaws 21 and 26 more narrow than the thickness of the gunwale in Thibodeau. Motivation to do so is to bring the jaws 21 and 26 into contact or almost into contact with each other for storage of the attachment of Thibodeau.

With regard to claim 18 the gunwale of Thibodeau is 18, the two clamp parts are arms 19 and 25, the nose part of each clamp part receives pintle 24, arm 25 having two noses with a shoulder there between and arm 19 having one nose with a shoulder on each side, at least one fastener 24 which extends through each nose part, wherein the nose part of a first one of the clamp parts extends adjacent the shoulder portion of a second one of the clamp parts, wherein the nose part of the second one of the clamp parts extends adjacent the shoulder portion of the first one of the clamp parts, wherein the shoulder portions extend adjacent opposed sides of the gunwale, wherein the nose parts of each of the clamp parts extend around at least *a portion of* the gunwale to contact the shoulder portions, an aperture bounded by the clamp parts, wherein the aperture includes an opening portion that extends around the gunwale, wherein the aperture further includes a stem portion formed by jaws 21 and 26 that extends *adjacent* each side of a portion of the hull. Thibodeau does not disclose that a width of the stem portion is narrower than the width of the gunwale. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to adjust wing nut 30 of Thibodeau to make the distance between jaws 21 and 26 more narrow than the thickness of the gunwale in Thibodeau.

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Motivation to do so is to bring the jaws 21 and 26 into contact or almost into contact with each other for storage of the attachment of Thibodeau.

The tension device of claim 25 is made up of bolt 28 and wing nut 30.

With regard to new claim 28, Thibodeau discloses a method for mounting items to a gunwale of a boat comprising:

a) placing two clamp parts 19 and 25 adjacent opposed sides of a gunwale 18 of a boat, wherein

each clamp part include a nose part (in figure 1 the nose part of clamp part 19 is between the nose parts of claim 25) and a shoulder portion (in figure 2 the shoulder portions are shown by the broken lines making a circle around pintle 24) which nose part curves around an uppermost point on the gunwale (both noses curve around the outer upper corner point of the gunwale 18) and is in operative relation to the shoulder portion of the other clamp part (figure 2 shows the nose parts being in operative relationship with their shoulders) ; and

b) fastening the clamp parts together with at least one fastener 24 or 28, wherein the fastener prevents the clamp parts from moving in opposite directions along the gunwale, wherein the fastened clamp parts form a clamp with an aperture including an opening portion that extends around the gunwale and wherein the aperture further

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includes a stem portion defined by jaws 21 and 26 that extends *adjacent* each side of a portion of a hull of the boat which aperture is in operative connection with the gunwale and hull.

Thibodeau does not disclose wherein a width of the stem portion is narrower than the width of the gunwale.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to adjust wing nut 30 of Thibodeau to make the distance between jaws 21 and 26 more narrow than the thickness of the gunwale in Thibodeau. Motivation to do so is to locate the jaws 21 and 26 below the gunwale 18 and into contact with the hull below the gunwale. This can lead to better securement of the clamp to the boat

With regard to claim 29, Thibodeau discloses an apparatus for mounting items to a gunwale of a boat comprising:

a boat, wherein the boat includes a hull, wherein the hull includes a gunwale 18;

a clamp, wherein the clamp includes

at least two clamp parts 19 and 25, wherein each clamp part includes a nose part and a shoulder portion (the nose part of 19 is between the nose parts of 25 in figure 1 of Thibodeau and the shoulders are represented by the broken line circle around pintle 24 in figure 2 of Thibodeau);

wherein the nose part of a first one of the clamp parts extends adjacent the shoulder portion of a second one of the clamp parts, wherein the nose part of the



second one of the clamp parts extends adjacent the shoulder portion of the first one of the clamp parts, wherein the shoulder portions extend *adjacent* opposed sides of the gunwale, wherein the nose part of each clamp part extends around at least a portion of the gunwale to operatively contact the shoulder portion of the other clamp part to prevent the clamp from opening and releasing the gunwale; an aperture bounded by the clamp parts, wherein the aperture includes an opening portion that extends around the gunwale, and wherein the aperture further includes a stem portion defined by jaws 21 and 26 that extends adjacent each side of a portion of the hull

Thibodeau does not disclose wherein a width of the stem portion is narrower than the width of the gunwale.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to adjust wing nut 30 of Thibodeau to make the distance between jaws 21 and 26 more narrow than the thickness of the gunwale in Thibodeau. Motivation to do so is to bring the jaws 21 and 26 into contact with the hull area of the boat beneath the gunwale for better securement of the clamp to the boat of Thibodeau.

6. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thibodeau in view of Robbins. Thibodeau does not disclose that one cushioning insert is placed between the gunwale and the first and second clamp parts. Note the clamping shoe 11 of Robbins which is rubber. It would have been obvious at the time

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the invention was made to a person having ordinary skill in the art to which said subject matter pertains to provide clamping shoes of rubber to the jaws 21 and 26 of Thibodeau in view of shoes 11 of Robbins. Motivation to do so is to protect the gunwale of the boat of Thibodeau from being marred by the jaws.

***Allowable Subject Matter***

7. Claims 5, 6, 9, 10, 11, 15, 16, 17 and 19-24 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter: The reasons for allowing claims 5, 6, 9-11, 15, 16, 17 and 19-24 are set forth in the first office action.

***Response to Arguments***

9. Applicant's arguments filed October 15, 2004 have been fully considered but they are not persuasive.
10. Applicant's arguments in the first and second paragraphs on page 28 of his response filed October 15, 2004 are rebutted as follows. First of all it is pointed out that pintle 24 fastens all noses and shoulders to each other. But claim 21 does not require this. Claim 1 defines the noses being placed adjacent the shoulders. In Thibodeau each nose is placed adjacent a shoulder of the other clamp part. In figure 2 of Thibodeau the circle around pintle 24 made up of broken lines and a somewhat solid line depicts the end of the noses and the shoulders in which they bed and to which they are adjacent. For each clamp part, the nose and the shoulder form a circle with its

center on pintle 24. With respect to the clamp, the nose would form an outer part of the circle and the shoulder would form an inner part of the circle.

11. With regard to the arguments presented by applicant in his response filed October 15, 2004 beginning at the bottom of page 28 and in the first two paragraphs on page 29, rebuttal is as follows

Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. See MPED 2112.02.

12. Applicant's arguments regarding claims 3 and 4 are noted. Since the rejection of anticipation of claim 1 by Thibodeau stands, these arguments fall. These arguments basically state that claims 3 and 4 are allowed because claim 1 is allowable over Thibodeau.

13. With regard to claim 14, applicant argues that claim 14 is an independent claim which is specifically directed to a method claim. Applicant respectfully submitted that Thibodeau does not disclose a method, but an apparatus. This argument is rebutted by repeating the following from above:

Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. **When the prior art device is**

**the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. See MPED 2112.02.**

14. The above rebuttal would also apply to applicant's arguments concerning the modification of Thibodeau to make the width between the jaws 21 and 26 less than the width of the gunwale. Because the clamp of Thibodeau is the same as applicant's, it can be assumed that the device will perform the claimed step with regard to the width of the stem and gunwale.

15. In rebuttal of applicant's arguments concerning claim 18, the clamp of Thibodeau is capable of being adjusted such that the width between jaws 21 and 26, which together form the claimed stem, becomes more narrow than the width of the gunwale—even while attached to the boat. For example, this can depend on where the jaws are placed. If the jaws are placed beneath the gunwale to attach to the hull, they can be adjusted to have a width more narrow than that of the gunwale. Because one could adjust the width between the jaws 21 and 26 to be more narrow than the width of the gunwale, claiming this feature does not lend patentability to a claim.

16. For the above reason, the rejections set forth above stand.

### ***Conclusion***

17. Applicant's amendment by the addition of three new claims necessitated the new ground(s) of rejection with respect to those new claims presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

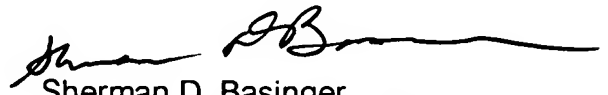
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sherman D. Basinger  
Primary Examiner  
Art Unit 3617  
11/4/04

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